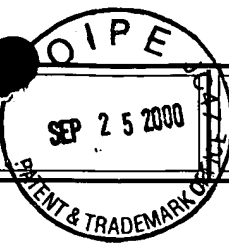


TRANSMITTAL OF APPEAL BRIEF (Large Entity)



Docket No.
112688-003

AF\$
GAL 1733

#18

In Re Application Of:

Farquhar et al.

Serial No.
08/818,520

Filing Date
March 14, 1997

Examiner
S. Yao

Group Art Unit
1733

Invention:

PCMCIA STANDARD MEMORY CARD FRAME

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on July 21, 2000

The fee for filing this Appeal Brief is: \$300.00

- ☒ A check in the amount of the fee is enclosed.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 02-1818
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Dated: September 21, 2000

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I certify that this document and fee is being deposited on 9/21/00 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

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Typed or Printed Name of Person Mailing Correspondence

cc:



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS**

APPLICANT:	Farquhar et al.	DOCKET NO:	112688-003
SERIAL NO.:	08/818,520	ART UNIT:	1733
DATE FILED:	March 14, 1997	EXAMINER:	S. Yao
INVENTION:	"PCMCIA STANDARD MEMORY CARD FRAME"		

#18/1/2/3
1/2/3

Hon. Assistant Commissioner for Patents

Washington, D.C. 20231

APPELLANTS' APPEAL BRIEF

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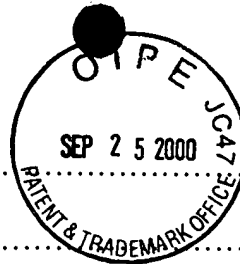
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS**

APPLICANT:	Farquhar et al.	DOCKET NO:	P97,0500-R
SERIAL NO.:	08/818,520	ART UNIT:	1733
DATE FILED:	March 14, 1997	EXAMINER:	S. Yao
INVENTION:	"PCMCIA STANDARD MEMORY CARD FRAME"		

Hon. Assistant Commissioner for Patents
Washington, D.C. 20231

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APPELLANTS' APPEAL BRIEF

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal submitted by Appellants on July 21, 2000 and received by the Patent Office on July 28, 2000.

I. REAL PARTY IN INTEREST

The real party in interest for the above-identified patent application on appeal is Methode Electronics, Inc. by virtue of an Assignment recorded at the United States Patent and Trademark Office at reel 7854, frame 0298.

II. RELATED APPEALS AND INTERFERENCES

Appellants do not believe there are any related appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

III. STATUS OF CLAIMS

Claims 7-28 are currently on appeal (a copy of the claims on appeal is attached hereto as the Appendix). In an Office Action dated April 28, 2000, Claims 7-28 stand rejected under 35 U.S.C. § 112, Claims 26-27 are objected to under 37 CFR 1.75 (c), Claim 25 stands rejected under 35 U.S.C. § 102, and Claims 7-27 stand rejected under 35 U.S.C. § 251. A copy of the final rejection is attached hereto as Exhibit A of the Supplemental Appendix. Claims 1-6 have been noted to be allowed.

IV. STATUS OF AMENDMENTS

Appellants are submitting herewith an Amendment canceling Claims 15 and 21 and therefore removing these claims from this Appeal. All other amendments have been entered.

V. SUMMARY OF THE INVENTION

The patent application on appeal is a reissue application. In this regard, on March 14, 1997 Appellants submitted the above-identified reissue application for U.S. Patent No. 5,397,857. For the convenience of the Board in discussing the reissue application and specifically, summarizing the invention, reference is made to the patent document as submitted to the Patent Office as part of the reissue patent application. A copy of the patent document is attached hereto as Exhibit B of the Supplemental Appendix for the convenience of the Board.

The present invention relates generally to memory media in I/O device containers. In a particular embodiment, the present invention relates to packaging containers for printed circuit boards that conform to certain standards for peripheral devices. In order to expand a portable, laptop, or any other type of computer's capacity and functioning capability, manufacturers have devised plug-in peripheral cards in the form of printed circuit boards. These printed circuit boards need to be housed in a container. (See column 1, lines 5-20.)

Generally, the present invention provides a container for peripheral devices. The container includes two stamped metal covers, an upper and a lower cover half. Each is secured to a plastic frame element. The cover halves may be secured by extended fingers. (See column 1, lines 57-61.)

The two cover halves are designed to encapsulate a printed circuit board (PCB). The cover halves affix the PCB in its proper position. These cover halves can be welded together

using sonic welding on the plastic frame or resistant welding on the covers. (See column 1, lines 64-68.)

Attached as Exhibit C to the Supplemental Appendix is a copy of the drawings for the reissue application. Reference is now made to the drawings in this further description of the invention.

The package includes an upper cover 12, a lower cover 14, upper frame member 16, and lower frame 18. In a preferred embodiment, the covers 12 and 14 are formed from stamped metal and the frames 16 and 18 from molded plastic though there is no requirement that the cover be constructed from stamped metal. The covers 12 and 14 generally will be mirror images of each other, but may not be in certain applications. (See column 2, lines 57-68, and column 3, lines 4-5.)

In an embodiment that may facilitate bonding, the edges of the covers 12 and 14 are bent to conform to the shape of the frame elements 16 and 18. Additionally, in the embodiment metal fingers 26 are provided in each side of the covers 12 and 14. The metal fingers 26 become embedded in the plastic frame elements during the bonding and molding process to form an integral frame cover element. (See column 3, lines 25-31.)

As illustrated, in an embodiment, a lower energy director 20 extends above one-half of the perimeter upper surface of the lower frame element 18. A corresponding energy director element 22 extends along one-half of the lower perimeter surface of the upper frame element 16. These energy directors 20 and 22 mate with the corresponding frame surface to form the weld during the sonic welding process.

The specification also sets forth a method for manufacturing the package of the present invention.

The invention of the above-identified patent application provides many advantages including the following. Joinder of the two package halves is accomplished without the use of adhesives. This leads to greater reliability of the memory card. Very few components are used, minimizing manufacturing costs. Further, devices constructed according to the invention lend themselves to automated assembly. The process of manufacturing the claimed invention allows the card manufacturer, if desired, to bond only similar materials, plastic to plastic, since the bonding of the dissimilar materials, plastic to metal, can be accomplished by the package manufacturer. (See column 2, lines 4-36.)

Due to the design of the package, more space for the PCB is available within a given package volume. Moreover, the invention provides a memory card container that is stronger than prior art containers. The device of the invention is very versatile, and can be used for types I, II, III, and IV boards. If desired, the application of a non-conductive layer to the two cover halves prior to stamping allows the package to have a non-conductive interior. An embodiment of the design allows the PCB to be fixed in place by opposing plastic elements ("bosses") at any level within the package. Another advantage of the design is that the PCB connectors and/or other I/O devices can be clamped between the cover halves. Overall package thickness can be controlled to a very strict tolerance. If desired, the package can provide variable grounding locations along the length of the package sides. (See column 2, lines 4-36.)

VI. ISSUES

The following issues are on appeal in this action:

- I. Does the specification support the proposed drawing correction set forth on the substituted sheet of drawings (a copy of which is attached to the Supplemental Appendix as Exhibit D)?
- II. Is the phrase "[a]s shown in Figure 4, the edges of the covers 12 and 14 have a generally U-shaped configuration" new subject matter not supported by the original specification?
- III. Are Claims 26 and 27 in proper dependent form?
- IV. Do Claims 7-28 contain subject matter which is described in the specification in a sufficient manner to meet the requirements of 35 U.S.C. § 112?
- V. Are Claims 18-23 or 25-27 sufficiently definite to meet the requirements of 35 U.S.C. § 112?
- VI. Is Claim 25 anticipated by U.S. Patent No. 5,228,732?
- VII. Do Claims 7-27 constitute an improper attempt under 35 U.S.C. § 251 to recapture subject matter?

VII. GROUPING OF CLAIMS

Appellants argue for the separate patentability of each of the independent claims separate and apart from each other, as well as the dependent claims separate and apart from the

independent claims from which they depend, as set forth below pursuant to the requirements of 37 CFR § 1.192(7), unless otherwise specified.

VIII. ARGUMENTS

A. BACKGROUND OF THE REISSUE APPLICATION

On March 14, 1997, Appellants submitted the above-identified reissue patent application. Accordingly, this reissue application has been pending for over three years.

The reissue application was filed after it was determined that the invention of the patent upon which the reissue application is based, U.S. Patent No. 5,397,857 (hereinafter '857 Patent) could be distinguished over the prior art in a number of ways that were not currently claimed in the '857 Patent nor appreciated during the filing of the application from which the '857 Patent issued (See Inventor's Declaration, a copy of which is attached to the Supplemental Appendix as Exhibit E).

In this regard, claims were submitted in the reissue application which do not include certain limitations in the original claims and which claims were patentable over the prior art. As the inventors noted in their declarations, it was their unintended mistake that the only independent claim that issued in the '857 Patent was written to read on the preferred embodiment of their invention in which a finger extends from each of the metal covers and each finger is secured to a plastic frame element by injection molding the plastic frame element around the finger. Accordingly, in the revised Application, new claims were submitted which were supported by the specification and not disclosed or suggested by the prior art.

This reissue application was filed within two years of the allowance of the '857 Patent. Accordingly, the reissue application can enlarge the scope of the claims of the '857 Patent. See 35 U.S.C. § 251.

B. THE REJECTIONS

Aside from the rejection of Claim 25 as being anticipated by U.S. Patent No. 5,228,732, none of the remaining claims, i.e., Claims 7-24, and 26-27, stand rejected based on prior art. The

sole issues with respect to these claims relate to rejections under 35 U.S.C. § 112 or related legal issues and/or questions of reissue practice.

At the outset, the Office Action objects to a drawing change that was submitted during the reissue proceeding in response to an objection by the Examiner. The Examiner claims the proposed drawing change introduces new matter. Additionally, the specification is objected to in view of an Amendment submitted thereto which the Examiner states constitutes new matter not supported by the original disclosure.

Claims 26-27 stand objected to as being in improper dependent form. In this regard, the Patent Office states that these claims fail to further limit the subject matter of the previous claim.

Claims 7-28 stand rejected under 35 U.S.C. § 112 as the Patent Office states that these claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed had possession of the claimed invention.

Claims 15, 18-23, and 25-27 stand rejected under 35 U.S.C. § 112 as being indefinite.

The only claim rejected based on prior art is Claim 25. This claim the Patent Office states is anticipated by U.S. Patent No. 5,208,732 (*Baudouin*). A copy of *Baudouin* is attached to the Supplemental Appendix as Exhibit F.

Lastly, Claims 7-27 stand rejected under 35 U.S.C. § 251 as being an alleged improper recapture of claimed subject matter that was allegedly cancelled in the application for the patent upon which the present reissue is based.

C. THE PROPOSED AMENDMENTS DO NOT ADD NEW SUBJECT MATTER

1. The Proposed Amendment to the Drawings Does Not Add New Matter

The Patent Office originally objected to the drawings and specifically Figure 2 for failing to show energy director element 22. Appellants submitted proposed drawing changes showing the energy director 22 (a copy of the proposed drawing change is located at Exhibit D). However, the Examiner disapproved of the Amendment on the basis of new matter. In this regard, the Examiner states that the original disclosure does not provide sufficient support for energy director 22 being in the form of a grooved as illustrated in Figure 2a. Appellants respectfully submit that this objection/rejection is not proper.

The original drawing clearly shows a lower energy director 20 that extends upwardly in a v-shaped fashion along the upper surface of the lower frame element 18 (see Figure 2 of the original patent, a copy of which is attached as Exhibit B). The specification further describes:

a corresponding energy director element 22 [that] extends along one-half of the lower perimeter surface of the upper frame element 18. These energy directors 20 & 22 mate with corresponding frame surface to form the weld during the sonic welding process.

See column 3, lines 14-19, emphasis added.

Based on this disclosure of an upwardly shaped energy director 20 that mates with the other energy director 22, those skilled in the art would clearly recognize that the corresponding energy director 22 must be a groove as shown in the proposed drawing change set forth in Figure 2a. Accordingly, Appellants respectfully submit that the proposed drawing change is not new matter.

In response to Appellants' arguments, the Examiner admits that the disclosure does suggest mating energy directors 20 and 22. However, the Examiner states that this does not necessarily suggest that the energy director 22 must be a groove, but it could have the same configuration as energy director 20 shown in Figure 2a. Appellants respectfully submit that this rationale demonstrates that the rejection is not proper.

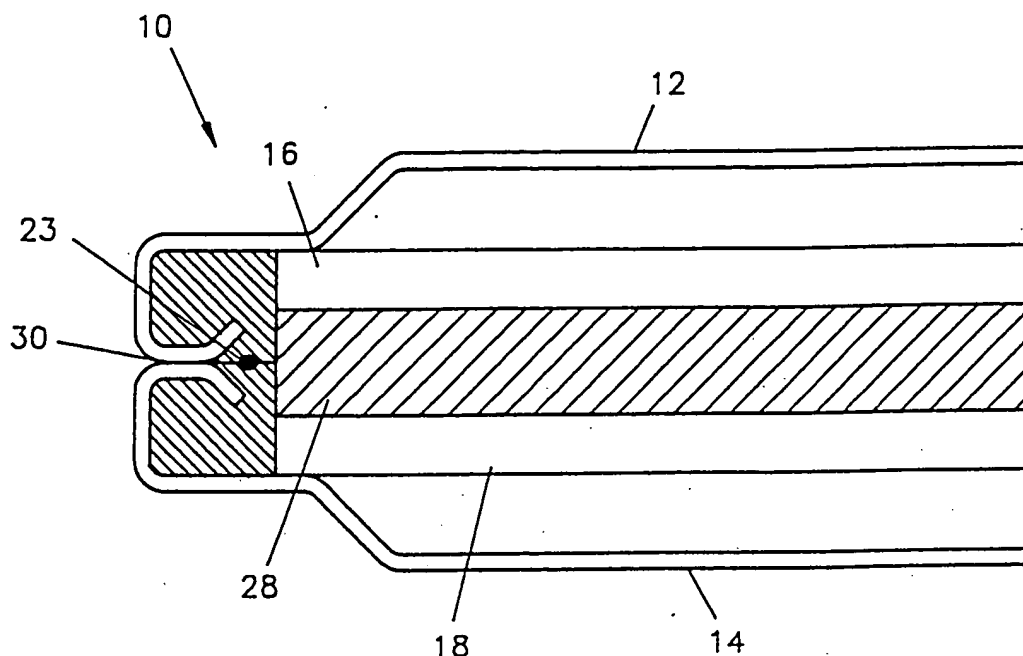
If energy directors 20 and 22 were of the same shape, they could not mate. Webster's Ninth New Collegiate Dictionary defines mate as follows: "to join or fit together." One skilled in the art, reviewing Appellants disclosure in view of the energy director 20 illustrated in Figure 2 and the specification that states energy director 22 should mate with energy director 20 would be led to the conclusion that the energy director 22 should be a groove as illustrated in Figure 2a. Appellants respectfully submit that this is clear and the addition of the groove to the figures as set forth in proposed Figure 2a is not new matter. Therefore, Appellants respectfully request that the rejection to the proposed drawing change be reversed.

2. The Proposed Amendment to the Specification Does Not Add New Matter

The Patent Office objects to the specification in view of the addition of the phrase "as shown in Figure 4, the edges of the covers 12 and 14 have a generally U-shaped configuration." This phrase was added because the patent office stated that the specification did not provide adequate support for this claimed element. The Patent Office now states the original disclosure

does not provide sufficient support to broadly state that the edges of the covers have a generally U-shaped configuration.

Appellants respectfully submit that this statement is incorrect. Set forth below is Figure 4.



Clearly this figure illustrates a generally U-shaped configuration of the edges of the covers. This figure was part of the original disclosure. Thus, the figure provides adequate support for this claimed element (a drawing with no written description provides sufficient support to present new claims to the illustrated feature, *Vas-Cath Inc. v. Mahurkar*, 19 USPQ 2d 1111 (Fed. Cir. 1991)). Moreover, the figure provides adequate support for the proposed amendment to the specification. Therefore, Appellants respectfully request that the rejection be withdrawn.

D. CLAIMS 26 AND 27 ARE IN PROPER DEPENDENT FORM

The Patent Office has objected to Claims 26-27 under 37 CFR § 1.75 (c) as being in improper dependent form for allegedly failing to further limit the subject matter of a previous claim.

Claim 26 depends from Claim 25 and Claim 27 depends from Claim 26. Claim 25 claims in part “means for securing said first and second metal covers to said first and second plastic frame elements.” Claims 26 and 27 provide as follows:

26. The package of Claim 25 in which said means comprises edges of said first and second metal covers that are bent to conform to the shape of the

corresponding first and second frame element and to hold said first and second covers to said first and second plastic frame elements.

27. The package of Claim 26 in which said means further comprises fingers on said first and second covers which are embedded into said first and second plastic frame elements which are injection molded around said fingers.

Of course, 35 U.S.C. § 112, ¶ 6 sets forth how means plus function claims are to be interpreted. Means plus function claims are to “be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” 35 U.S.C. §112 ¶ 6.

Claim 25 sets forth means for securing the first and second metal covers to the first and second plastic frame elements. Claim 26 states that the means comprises edges of the first and second metal covers that are bent to conform to the shape of the corresponding first and second frame element to hold the first and second covers to the first and second plastic frame elements. This is a specific embodiment of the invention that is set forth in the reissue patent application. Of course, not only is the language of Claim 25 to be interpreted to cover this embodiment, but also equivalents thereto. See 35 U.S.C. § 112, ¶ 6. A variety of equivalents to the disclosed means structure could be imagined, for example, first and second metal covers do not need to be bent to conform to the shape of the corresponding first and second frame elements or they can only be partially bent to conform, or only one of the elements needs to be bent to conform. Clearly, Claim 26 is not of improper dependent form as it further limits the scope of Claim 25; it limits the claimed element “means for securing.”

Dependent Claim 27, which depends from Claim 26, clearly demonstrates that the rejection of Claims 26 as being of improper dependent form is incorrect as a matter of fact. In this regard, Claim 27 adds further limitations to Claim 26 with respect to the definition of the means for securing. Claim 27 requires that the means for securing also comprises fingers on the first and second covers which are embedded in the first and second plastic frame elements by the frame elements being injection molded around the fingers. Similar to Claim 26, there are a variety of equivalents to the embodiment of the invention which is specifically disclosed in the specification. For example, it is not necessary to have a finger on each of the first and second cover, in this regard, one finger on one cover could be utilized. Further, it is not necessary for the plastic frame to be injection molded around the finger; or even for any finger to be present.

Claims 26 and 27 limit Claim 25 by reciting structure from the specific embodiment for the “means for securing” that is disclosed in the specification. Accordingly, Appellants respectfully submit that the rejection of Claims 26-27 as not being in proper dependent form is incorrect as a matter of law and fact and therefore should be reversed by this Board.

**E. CLAIMS 7-28 ARE DESCRIBED IN THE SPECIFICATION IN A MANNER
SUFFICIENT TO MEET THE REQUIREMENTS OF 35 U.S.C. § 112**

The Examiner has rejected Claims 7-28 as not meeting the requirements of 35 U.S.C. §112. Specifically, the Examiner stated that the claimed subject matter is not described in the specification in such a way to reasonably convey to one skilled in the art that the inventor had possession of the invention at the time it was filed. Appellants respectfully submit that this rejection is incorrect as a matter of law and fact and should be reversed.

1. The Applicable Law

The essential inquiry in determining compliance with the “original patent” clause of 35 U.S.C. § 251 or the “written description” requirement of 35 U.S.C. § 112, ¶ 1, is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as being invented and disclosed by the patentees. *Hester Industries, Inc. v. Stein Inc.*, 46 USPQ2d 1641, 1651 (Fed. Cir. 1998); and *In re Amos*, 21 USPQ2d 1271, 1274-75 (Fed. Cir. 1991).

The function of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application, of the specific subject matter later claimed by him. *In re Edwards*, 196 USPQ 465, 467 (CCPA 1998). To comply with the written description requirement, it is not necessary that the application describe the claimed invention in *ipsis verbis*. *Id.* Indeed, it is immaterial how the application achieves compliance with the written description requirements. *In re Voss*, 194 USPQ 267, 271 (CCPA 1977); and *In re Smith* 178 USPQ (CCPA 1973). Rather “all that is required is that it [the specification] reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him.” *id.* Moreover, it should be noted that the Patent Office has the initial burden of presenting evidence or reasons why those skilled in the art would not recognize in the specification a description of the later claimed invention. *In re Voss*, 194 USPQ at 271.

Of course, the applicable legal provisions permit an applicant to submit claims that are broader than the specific embodiment of the invention shown in the specification. In a similar vein, they permit a reissue applicant to submit claims that are broader than the specific embodiments shown in the specification. In two cases remarkably similar to the facts involved in this case, the Federal Circuit and the CCPA specifically approved such claims in a reissue Application.

In *In re Rasmussen*, 211 USPQ 323, 326 (CCPA 1981), the CCPA reaffirmed that reissue claims may be broader than specific embodiments disclosed in the specification:

Broadening a claim does not add new matter to the disclosure. Disclosure is that which is taught, not that which is claimed. An applicant is entitled to claims as broad as the prior art and his disclosure will allow . . .

As above indicated, that a claim may be broader than the specific embodiment disclosed in a specification in itself is of no moment. Indeed, the statutory provision for broadened claims in reissue applications is intended to meet precisely the situation in which a patentee has claimed 'less' than he had a right to claim. 35 U.S.C. 251" (footnote omitted).

In re Rasmussen, 211 U.S.C. at 326.

The facts of *In re Rasmussen* are instructive. In that case, the applicant's specification only described one specific method of using adhesive to stick two layers together. The applicant submitted broadened reissue claims which only described "adherently applying" one layer to an adjacent layer and omitted certain steps. The CCPA reversed the rejection of the Examiner and held that the applicant was entitled to the broadened reissue claims.

In *In re Peters*, 221 USPQ 952 (Fed. Cir. 1983), the Federal Circuit specifically followed the ruling from *In re Rasmussen*, 211 USPQ 323. In *In re Peters*, the patent disclosed a device including tapered tips. The applicants sought broadened reissue claims that read on both tapered and non-tapered tips. The Board affirmed the Examiner rejection of the claims under 35 U.S.C. §§ 251 and 112, ¶1. However, the Federal Circuit reversed. In accordance with *In re Rasmussen*, the Federal Circuit held that applicants were entitled to submit reissue claims that were broader than the specific embodiment shown in the specification.

Similar to the situation in *In re Rasmussen* and *In re Peters*, in the present appeal, the Examiner is attempting to restrict appellants to the specific elements disclosed in their Patent

Application. The law however, permits Appellants to submit reissue claims that are broader than the specific embodiment disclosed in the specification. See *In re Rasmussen*, 211 USPQ at 326; *In re Peters*, 221 USPQ 952. Thus, as a matter of law the Examiner's rejections of Claims 7-22 under 35 U.S.C. § 112 is incorrect and should be reversed.

2. Claims 7-28 Are Supported by the Specification

Although the Examiner makes a blanket rejection of Claims 7-28 under 35 U.S.C. §112, he does specifically discuss a number of the claims and Appellants will now address each of these claims in the order they are raised in the final rejection.

a. Claim 7

Claim 7 claims, in part, "each cover having a first side and a second side with at least one finger extending from each of said sides." In the Office Action, the Examiner states that the recitation of at least one finger on each of the sides raises new matter. It is respectfully submitted that this rejection is improper.

The specification provides support for Claim 7 because the specification discloses an embodiment of the invention with at least one finger on each of the two sides. For example, clearly Figure 3 illustrates at least one finger extending from each of the two sides. Thus, the specification provides adequate support because the claim reads directly on the disclosed embodiment. Therefore, clearly this claim does not add new matter.

The fact that the claim is broader than the specific embodiment shown in the specification does not raise a new matter concern. Both the CCPA and the Federal Circuit have expressly approved claims that are broader than the specific embodiments in the specification; even when those claims are presented for the first time in a reissue application. See *In re Rasmussen*, 211 USPQ at 326; *In re Peters*, 221 USPQ 952.

Indeed, in view of the disclosure and applicable case law, the only rationale for the rejection appears to be that the Examiner may be requiring that the disclosure show an objective intent to claim the invention as now claimed. However, the Federal Court has expressly rejected "an intent to claim" standard. See *Hester Industries Inc. v. Stein Inc.* 46 USPQ2d 1641, 1651 (Fed. Cir. 1998). Rather, the issue is whether the claims read on the disclosure, and the present claims clearly read on the disclosure. Thus, the claims are adequately supported by the specification. The fact that the claims are broader than the particular embodiment shown in the

specification is irrelevant. See *In re Rasmussen, supra*, *In re Peters, supra*. Accordingly, the rejection of Claim 7 under 35 U.S.C. § 112 should be reversed.

b. Claims 9 and 16

Claims 9 and 16 claim, in part, a “plurality of fingers [that] extend from at least two sides.” In the Office Action, the Examiner contends that these claims raise issues of new matter because they read on a device with fingers “on three or four sides of the metallic cover.”

Applicants note for the record that all of the claims of this application, including originally allowed claim 1, would read on a cover using fingers on all four sides. In this regard, all the claims use the transitional term “comprising”, and such claims can read on devices including additional elements. The use of “comprising” as a transition phrase in such open ended claims is a well accepted practice, and it is perfectly appropriate for the claims to read on devices that include additional elements. Similarly, Claims 9 and 16, which read directly on the disclosed embodiment, can also read on devices that include additional elements without violating 35 U.S.C. §112.

Moreover, these claims are supported by the disclosure; for example, Figure 3 of the reissue application illustrates a plurality of fingers extending from two sides. Thus, Appellants submit that the rejection of Claims 9 and 16 under 35 U.S.C. § 112 is improper and should be reversed.

c. Claim 11

Claim 11 claims, in part, “at least one finger extending from each of said sides of each cover.” The Patent Office states that this raises an issue of new matter for the same reasons as set forth above. Appellants respectfully submit that this rejection is incorrect as a matter of law and fact.

The specification clearly discloses at least one finger extending from each of the sides of the covers. For example, see Figure 3. The fact that Claim 11 is broader than the preferred embodiments set forth in the specification does not render the claim as not being supported under 35 U.S.C. § 112 and constituting new matter. Claim 11 is supported by the specification, the specification discloses at least one finger extending from each of the sides. Therefore, Appellants respectfully request that the rejection be reversed.

d. Claim 15

Claim 15 claims, in part, “wherein a finger extends from one of said sides.” The Patent Office states this new matter. Appellants respectfully submit this claim does not constitute new matter. Again, clearly this element is disclosed in the specification and figures.

However, Appellants believe that this claim is redundant in view of Claim 11 and therefore believe this claim should be cancelled without prejudice or disclaimer. Appellants are submitting herewith an Amendment canceling Claim 15 and respectfully request that it be entered. Therefore, this issue is now moot.

e. Claim 18

Claim 18 has been rejected as raising an issue of new matter. Claim 18 claims “a first package half including a stamped metal cover and a frame element, said cover having an edge bent to conform to a shape of said frame in a generally U-shaped configuration with said frame element being injection molded within the U-shaped edge of the metal cover.” The Examiner has rejected Claim 18 as not being supported by the disclosure on two grounds: (1) no alleged disclosure for a U-shaped edge; and (2) new matter issues due to no references to fingers in the claim. Applicants respectfully submit that both rejections are improper.

Regarding the U-shaped edge, applicants direct the Board’s attention to Figure 4. Figure 4 clearly shows that the edge of the metal cover is bent into a generally U-shaped configuration. Those skilled in the art would clearly recognize the “U-shaped edge” of the metal cover; and Appellants have amended the specification to specifically refer to the U-shaped edge to make this clear.

The Examiner, in support of this rejection, notes that in Figure 4 “the edge portion of the metal covers are bent towards the metal covers.” Appellants submit that this statement is inapposite. Even though the terminal point of the edge of the cover is slightly bent, this does not alter the two previous bends in the edge that form the generally U-shaped configuration. The cover still has a generally U-shape. As long as those skilled in the art understand that the U-shaped edge is shown in Figure 4, the claim is supported by the specification and adequately defined within the requirements of 35 U.S.C. §112.

The Examiner, in attempting to rebut Appellants’ argument, asks the Appellant to point out where in the specification the phrase “U-shaped” is used. This argument is misplaced. As previously noted, a drawing, with no written description in the specification, is sufficient support

to present new claims supported by only the drawings. *Vas-Cath Inc., v. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir 1991). Thus, the Examiner's request that the Appellants must cite to a passage in the specification in order to demonstrate that the rejection is not proper is incorrect. Language in the specification is not necessary to meet the requirements of 35 U.S.C. § 112.

With regard to the fact that Claim 18 does not reference fingers; Appellants respectfully submit that the new matter rejection is based on incorrect application of the law. An applicant is entitled to claims as broad as the prior art and his disclosure will allow. The reissue statute expressly permits reissue claims that are broader than specific embodiments shown in the specification. *In re Rasmussen, supra*, *In re Peters, supra*. The fact that the specification shows fingers does not mean it is required that this element must be present in the claims. As a matter of fact and law, Appellants can submit claims that are supported and do not constitute new matter without reciting fingers as a claim element. Accordingly, the new matter rejection of Claim 18 should be reversed.

f. Claim 21

Claim 21 stands rejected as raising an issue of new matter. Pursuant to the Amendment being submitted herewith, Claim 21 has been cancelled without prejudice or disclaimer. Therefore, this rejection is now moot.

g. Claims 22-23

With regard to Claims 22-23, the Examiner has objected to the description of the frame element being "injection molded partially around the edge." The patent office states that the specification fails to teach this claimed element. This rejection, it is respectfully submitted, is incorrect as a matter of fact.

The specification of the '857 patent teaches that the fingers are embedded into the frame element to prevent separation of the covers from the frame elements (see, for example, column 3, lines 52-56). The specification does not state the degree to which the fingers are embedded i.e., either partially or fully. As viewed by one skilled in the art, the degree that the fingers are embedded would not appear to matter as long as they are sufficiently embedded in order to prevent separation of the covers and frame elements. One skilled in the art would understand this from the disclosure. See Wingfield Declaration ¶9 attached hereto as Exhibit G. Accordingly, the specification supports the phrase "partially around the edge" and Claims 22-23 do not describe new matter. Therefore, the rejection should be reversed.

h. Claim 24

Claim 24 claims edges including fingers and describes the metal covers having edges bent to conform to the shape of the frames. The Examiner rejects this claim as not being supported by the specification because it reads on one, three, or all edges being bent or one, three or all sides having fingers. This rejection, it is respectfully submitted, is based on a misapplication of the law.

There is no requirement in the law that the claims must be limited to the disclosed embodiment, e.g., that they specify that there are multiple fingers or a plurality of fingers on each of the sides of the cover. As set forth above, legally Appellants are entitled to submit reissue claims that are broader than the specific embodiment shown in the specification. *In re Rasmussen, supra*; *In re Peters, supra*, the question is whether or not the claims meet the requirements of 35 U.S.C. §112 which they do. Clearly, the specifications and drawings disclose edges including fingers and the metal cover having edges bent to conform to the shape of the frame.

Accordingly, the rejection of Claim 24 should be reversed.

i. Claims 25-27

Claim 25 describes “means for securing said first and second metal covers to said first and second plastic frame elements.” In rejecting this claim, the Examiner states as follows:

In claim 25, the limitations in this claim do not require 1st and 2nd sides having fingers; the edges of the sides being bent; and fingers being bent; and fingers being embedded in the frames by injection molding process. Moreover, the recitation of “means for securing . . .” raises an issue of New Matter. Note: in accordance with 35 U.S.C §112, paragraph 6, the use of means plus function language is construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. In view of Applicant’s recitation of dependent claims 26-27 structurally further limiting the “means for securing . . .” (thus implying that the “means for securing . . .” is not limited to the structure described in the specification, but could other structures NOT disclosed and considered to be equivalents thereof); and in view that the whole disclosure does not provide sufficient support of having different embodiments that are structurally equivalent to the one disclosed in the specification; this claim raises an issue of New Matter.

This rejection is based, it is respectfully submitted, on an incorrect interpretation of the law. As couched above, the Examiner’s rejection would appear to preclude a patentee from ever using means for claims.

In accordance with 35 U.S.C. §112, ¶6, the use of means plus function language refers to the structure shown in the specification and equivalents thereto. Claim 25 is clearly supported by the specification because it uses “means for” language. This language incorporates the specific means set forth in the specification by reference pursuant to the statutory language. 35 U.S.C. § 112, ¶ 6. Thus, by law, “means for” language can not be new matter. Therefore, the rejection should be reversed.

Claim 26 is rejected because it does not recite fingers and Claim 27 is rejected because it reads on one, two or three sides having fingers. Once again, it is respectfully submitted that these rejections are based on a misapplication of law. Clearly, the figures and specification support each of these claims. The fact that these claims do not include each and every element of the preferred embodiment is irrelevant. Therefore, Appellants request that the rejection be reversed.

j. Claim 28

Claim 28 has been rejected as being new matter. Claim 28 claims a cover having two edges bent generally in a U-shape with each of the edges including protruding portions adjacent open portions providing voids. The frame elements have injection molded portions with the U-shaped edges of the covers and the injection molded portions are contained within at least one of the voids on the edges of the covers in order to provide an integral unit. These protruding portions and voids are clearly shown in the drawings to the application since the illustrated fingers have spaces therebetween. Accordingly, this claim is supported by the specification, and the rejection should be reversed.

k. Appellants have provided evidence supporting their position.

As noted earlier, the burden is on the Examiner to present evidence of why those skilled in the art would not recognize in the specification a description of the later claimed invention. *In re Voss*, 194 USPQ at 271. The Examiner, it is respectfully submitted, has not done so. Regardless, in support of Appellants’ position that the specification establishes that the inventors had possession of the features described by the above claims, Appellants submitted the Declaration of James R. Wingfield, an adjunct professor at the Illinois Institute of Technology in the Department of Mechanical and Aerospace Engineering attached hereto as Exhibit G. As described in paragraphs 5, 7 and 9 of that Declaration, Mr. Wingfield has concluded that, based

on his review of the '857 patent, the inventors had possession of the features described by at least certain of the above claims in issue in this reissue application.

In particular, as described by Mr. Wingfield, the specification on the patent shows that the inventors have possession of a package having one or more fingers extending from the sides of the cover. Wingfield Declaration ¶5. Further, as described by Mr. Wingfield, the inventors had possession of a package in which the edges of the covers are formed into a U-shaped edge (as shown in Figure 4), and then a frame element is injection molded within the U-shaped edge of the metal cover. Wingfield Declaration ¶7. Further, the specification establishes that the inventors had possession of a package in which the fingers are partially or fully injection molded into the plastic frame elements. Wingfield Declaration ¶9.

The Examiner dismisses the Declaration of Mr. Wingfield stating he is only a lay person in determining whether a subject matter raises issues of new matter under 35 U.S.C. § 112. This statement is incorrect as a matter of law.

In contrast to the Examiner's position, the essential inquiry is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as being invented and disclosed by the patentees. *Hester*, 46 USPQ2d 1641; *In re Amos* 21 USPQ 2d at 1274-75. Mr. Wingfield is one skilled in the art. He stated he would identify the subject matter of the claims as being invented and disclosed by Appellants from reading the specification. This is relevant evidence that rebuts the Examiner's position. The claims fully comply with the written description requirement and the rejection should be reversed.

F. CLAIMS 10-23 AND 25-27 ARE SUFFICIENTLY DEFINITE

Claims 15, 18-23 and 25-27 stand rejected under 35 U.S.C §112 as allegedly being indefinite for failing to particularly point out the subject matter that the Applicant regards as his claimed invention. Appellants submit that these rejections are not proper or have been overcome.

With respect to Claim 15, this claim has been cancelled. Accordingly, this rejection is moot.

Claim 18 stands rejected as being indefinite because of the use of the term "generally U-shaped configuration." Claim 18 claims that the cover includes an edge bent to conform to a shape of said frame in a generally U-shaped configuration. The Examiner states that this claim is

indefinite because it is not clear which portion of cover is to be taken to be generally u-shaped configuration. Appellants do not understand this rejection. The claim specifically states that the edge of the cover is bent to conform to the base and be generally U-shaped in configuration. Accordingly, this rejection is not proper and should be reversed.

Claims 19-23 apparently are rejected on the same basis. Therefore the rejection of these claims under 35 U.S.C. § 112 should also be reversed.

Claims 25-27 stand rejected under 35 U.S.C. § 112 as being indefinite. The Patent Office states that it is unclear what is intended by the phrase “means for securing.” Of course, 35 U.S.C. §112 ¶6 allows for the use of “means for” language. Applicants have claimed means for securing. Pursuant to 35 U.S.C. § 112, ¶ 6, as a matter of law, the phrase “means for securing” has a definite meaning. It covers the means for securing set forth in the patent specification as well as equivalents thereto. Thus, as a matter of law, this claim is not indefinite and the rejection should be reversed.

G. CLAIM 25 IS NOT ANTICIPATED BY BAUDOUIN

Claim 25 stands rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by *Baudouin*. This Board will note, upon its review, that the Office Action fails to disclose or set forth any analysis of why it believes Claim 25 is anticipated by *Baudouin*. Appellants respectfully submit, that this rejection is improper. Claim 25 provides as follows:

25. A peripheral device PCB package comprising:
 - first and second stamped metal covers;
 - first and second plastic frame elements respectfully associated with said first and second stamped metal covers;
 - the first plastic frame element being bonded to the second plastic frame element to create an integral unit; and
 - means for securing said first and second metal covers to said first and second plastic frame elements.

The *Baudouin* reference, a copy of which is attached to Supplemental Appendix at D, woefully fails to anticipate the claimed invention. In this regard, Appellants respectfully submit that the means for securing the first and second metal covers to the first and second plastic frame elements is not disclosed. Once again, Appellants respectfully submit that this rejection is perhaps, it is respectfully submitted, based on a misinterpretation of “means for” language. “Means for” language is to be interpreted as including the structure specifically disclosed in the specification and equivalents thereto.

The means for securing in the specification sets forth a structure including a bent frame and finger members. Indeed, the majority of the Office Action attempts to limit Appellants to this specific structure. The equivalence thereof, as noted by Appellants, includes structures: that perhaps do not include fingers and have only a bent cover; perhaps only have one finger on each side of the cover; or the covers are bent but are not bent to conform to the frames or wherein only one of the covers is bent.

Not one of these structures is set forth in *Baudouin*. Thus, for this reason alone, *Baudouin* fails to anticipate Claim 25 as it fails to disclose the means for securing.

In order to anticipate the “means for securing” language, the Patent Office has to disclose a reference that includes the identical structure set forth in the specification or the equivalent thereto. The Patent Office has not even discussed this element in attempting to reject the claim as being anticipated. Therefore, Appellants respectfully submit that the anticipation rejection is clearly not proper and should be reversed.

H. THE RECAPTURE RULE

Claims 7-27 are rejected under 35 U.S.C. §251 as being an improper recapture of claimed subject matter. Appellant respectfully submits that this rejection is not proper.

1. Applicable Law

In order for the recapture rule to apply, an applicant must have clearly surrendered and canceled certain claim coverage from the claims in order to obtain allowance. *Ball Corp. v. United States*, USPQ 289, 295 (Fed. Cir. 1984). Further, reissue claims avoid the effect of the recapture rule if the reissue claims are narrower than the canceled claims. *Id* It should be noted that the Examiner relies on the Ball case. The Examiner’s reliance on the Ball case is misplaced. Ball supports Applicants in the present case.

2. Background

By way of background in the prosecution of the patent application that issued into the ‘857 Patent, in an Amendment B filed on August 3, 1994 applicants amended the claim to include the phrase “the plastic frame elements being injected molded around a plurality of fingers.” However, the Patent Office did not allow the claims in response to this amendment.

Thus, the mere recitation of “a plurality of fingers” was not the amendment that resulted in allowance of the case.

In subsequent interview with the Examiner and an Examiner’s Amendment, the Examiner and applicants’ representative discussed the prior art and the claims were further amended in order to obtain allowance. This amendment includes the recitation of describing the “edges of the metal covers [being] bent to conform to the shape of the frame.” Appellants respectfully submit that the bent edges of the metal covers was the limitation that resulted in allowance of the claims over the prior art.

In that regard, applicants direct the Board’s attention to *Baudouin et al.* (Exhibit D), which is a main reference cited during the original prosecution. *Baudouin et al.* does not disclose metal covers having bent edges, and this limitation clearly and definitively defined over the prior art.

Applicants respectfully submit that it is clear from the prosecution history of the original application that it was not critical to allowance whether the claims described one or more fingers. As a recitation of a “plurality of fingers” was not required for allowance, deletion of this limitation from the claims does not violate the recapture rule. *Ball, supra.*

3. The Claims Do Not Attempt to Recapture Cancelled Subject Matter

Appellants note that independent claims 7, 11, 18, 24 and 28 clearly described the edges of the metal covers being bent to conform to the shape of the frame or having a bent generally U-shaped configuration. As this limitation is contained in those claims, they are sufficiently narrow in accordance with the claims of the original prosecution to overcome any rejection based on the recapture rule.

Furthermore, Claims 18, 24, and 28 are even more narrow than the original claims by describing the frame elements being “sonically bonded.” As these claims are narrower than the original claims, these claims further do not violate the recapture rule. *Ball, supra.*

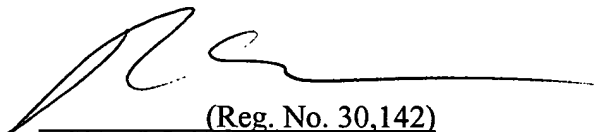
Claim 25 includes the phrase “means for securing.” As noted above, this element distinguishes over *Baudouin*. Thus, this claim does not attempt to recapture subject matter.

Thus, the rejection under 35 U.S.C. § 251 should be reversed.

IX. CONCLUSION

For the foregoing reasons, Appellants respectfully submit that the rejections of Claims 7-14, 16, 20, and 22-28 are improper as a matter of law and fact. Therefore, appellants respectfully request that the rejections be reversed.

Respectfully submitted,



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APPENDIX
Claims on Appeal

7. A peripheral device PCB package comprising:

two stamped metal covers with a plastic frame element corresponding to each cover, each cover having a first side and a second side with at least one finger extending from each of said sides and wherein edges of the metal covers are bent to conform to the shape of the corresponding frame element and said finger is secured to the plastic frame element forming an integral unit wherein each of the plastic frame elements is injection molded around the finger; and

wherein the plastic frame element extends beyond a plane of the metal cover so that a plastic perimeter surface is exposed, thereby facilitating bonding of the two covers.

8. The package as claimed in Claim 7 wherein a plurality of fingers extend from each of said sides.

9. The package as claimed in Claim 7 wherein a plurality of fingers extend from at least two sides.

10. The package as claimed in Claim 7 wherein the fingers are embedded in the plastic frame elements.

11. A peripheral device PCB package comprising:

two stamped metal covers having a first side and a second side with at least one finger extending from each of said sides of each cover; and

a plastic frame element associated with each of the covers, wherein edges of the metal covers are bent to conform to a shape of the frame and the plastic frame elements are injection molded to secure the fingers of each cover to the plastic frame element.

12. The package as claimed in Claim 11 further comprising:

a plastic perimeter surface extending beyond a plane of the metal cover to facilitate bonding of the two covers.

13. The package as claimed in Claim 12 wherein each of the plastic perimeter surfaces is integrally formed with the plastic frame elements.

14. The package as claimed in Claim 12 wherein the plastic perimeter surface is an energy director.

15. The package as claimed in Claim 11 wherein a finger extends from one of said sides.

16. The package as claimed in Claim 11 wherein a plurality of fingers extend from at least two sides.

17. The package as claimed in Claim 11 wherein the edge of the metal cover is bent to conform to the shape of the plastic frame element.

18. A PCB package comprising:
a first package half including a stamped metal cover and a frame element, said cover having an edge bent to conform to a shape of said frame in a generally U-shaped configuration with said frame element being injection molded within the U-shaped edge of the metal cover;
a second package half including a stamped metal cover and an injection molded frame element attached to the metal cover; and
the first package half sonically bonded to the second package half.

19. The package as claimed in Claim 18 wherein the frame element of the first package half includes a plastic perimeter surface with a raised surface to facilitate bonding with the second package half.

20. The package as claimed in Claim 19 wherein the plastic perimeter surface is an energy director.

21. The package as claimed in Claim 19 wherein the frame element of the second package half includes a plastic perimeter surface with a groove recessed below said surface to facilitate bonding with the first package half.

22. The package as claimed in Claim 18 wherein the edge is secured to the frame element and the frame element is injection molded partially around the edge.

23. The package as claimed in Claim 18 wherein a finger extends at an angle from the edge of the metal cover and the finger having the frame element partially injection molded around the finger.

24. A PCB package comprising:
first and second stamped metal covers;
first and second plastic frame elements respectively associated with said first and second covers, said metal covers having edges bent to conform to said frames and including fingers embedded in said frames which are injected molded around said fingers; and
the first frame element being sonically bonded to said second plastic frame element.

25. A peripheral device PCB package comprising:
first and second stamped metal covers;
first and second plastic frame elements respectively associated with said first and second stamped metal covers;
the first plastic frame element being bonded to the second plastic frame element to create an integral unit; and
means for securing said first and second metal covers to said first and second plastic frame elements.

26. The package of Claim 25 in which said means comprises edges of said first and second metal covers that are bent to conform to a shape of the corresponding first and second frame element and to hold said first and second covers to said first and second plastic frame elements.

27. The package of Claim 26 in which said means further comprises fingers on said first and second covers which are embedded into said first and second plastic frame elements which are injection molded around said fingers.

28. A PCB package comprising:

first and second metal covers, each cover having two edges bent generally in a U-shape, each of the edges including protruding portions, the protruding portions adjacent open portions providing voids;

first and second plastic frame elements respectively associated with the first and second metal covers, each of the plastic frame elements attached to each of corresponding metal cover by each frame element having an injection molded portion within the U-shaped edge of each side of each cover and the injection molded portion contained within at least one of said voids on each of the edges of the first and second metal covers in order to provide an integral unit combining the first plastic frame with the first metal cover and the second plastic frame with the second metal cover; and

the first frame element including a raised surface to provide for sonically bonding the first frame element to the second frame element in order to secure the first and second metal covers together.